Claim Rejections - 35 U.S.C. § 103

Claims 4 and 8 are rejected under 35 U.S.C. §103(a) as being obvious over Application No. 09/585,402 to Ishikawa et al. (now U.S. Patent No. 6,500,286) and further in view of von Arx (U.S. Patent No. 3,096,202).

Claims 5 and 8 are also rejected under 35 U.S.C. §103(a) as being obvious over Ishikawa et al. in view of Suzuki (JP 09155881).

Applicant respectfully disagrees. As explained by the Examiner, these rejections are based on the concept of derivation under 35 U.S.C. 102(f), in that it is alleged that the claimed invention has been derived from Ishikawa et al.

Applicant respectfully submits that the rejections are improper, at least in that Ishikawa et al. does not qualify as prior art under either section 102 or 103. Applicant notes the verified translations of the three priority documents that were filed on April 16, 2003. Applicant again points out that all of the priority dates (March 16, 1998; July 22, 1998; December 24, 1998) for the above-identified application are before both the U.S. filing date (June 2, 2000) and the priority date (June 3, 1999) of the Ishikawa et al. patent. Thus, it is not possible that the inventor of the present application, Toshio Yamagiwa, derived the claimed invention from Takeshi Ishikawa of the Ishikawa et al. patent. Applicant is aware that 35 U.S.C. 102(f) does not require an inquiry into the relative dates of a reference and the application. See MPEP 2137. Nevertheless, where it is shown that the inventor of an application conceived the claimed invention before the inventor of an alleged prior art reference, as in this case, Applicant urges that any derivation as alleged is not possible. Indeed, it is pointed out that "[d]erivation requires complete conception by another and

communication of that conception . . . to the party charged with derivation prior to any date on which it can be shown that the one charged with derivation possessed knowledge of the invention." See id. (citing *Kilbey v. Thiele*, 199 USPQ 290, 294 (Bd. Pat. Inter. 1978)) (emphasis added). Thus, if there is evidence to contradict Applicant's knowledge of the claimed invention prior to the priority date of the Ishikawa et al. patent, Applicant respectfully requests that the Examiner point to such evidence, so that the allegation of derivation may be properly supported, and Applicant may respond accordingly. However, in the absence of such evidence, Applicant respectfully submits that the rejection must be withdrawn.

Claim Rejections - Double Patenting

Claims 4 and 8 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 2 of Ishikawa et al. in view of von Arx.

Claims 5 and 8 are also provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 4 and 8 of Ishikawa et al. in view of von Arx and Suzuki.

Applicant respectfully disagrees. Applicant would again like to thank the Examiner for taking the time to fully explain the rejections. As explained by the Examiner, the MPEP §804, Charts I-B and II-B (attached) indicate that for this application, a double patenting rejection is proper where the application (1) has at least one common inventor and (2) no common assignee with the cited patent. However, reviewing the MPEP§804, Charts I-B and II-B more closely, it is seen that where there are multiple inventors, the phrase "common inventor" is used to refer to at least one the multiple inventors. Although the

application and Ishikawa et al. patent do share one common inventor, Toshio Yamagiwa, the application and Ishikawa et al. patent also share a common assignee, Honda Giken Kogyo Kabushiki Kaisha. Thus, the application and patent do not have "no common assignee" as required by the MPEP §804. Thus, both requirements for a double patenting rejection are not satisfied, and the improper rejection must be withdrawn.

In view of the above remarks, Applicant respectfully submits that this application is in condition for allowance and requests favorable action thereon.

In the event this paper is not considered to be timely filed, Applicant hereby petitions for an appropriate extension of time. The fee for this extension may be charged to our Deposit Account No. 01-2300, along with any other fees which may be required with respect to this application, referencing Attorney Docket No. 107348-00041.

Respectfully submitted,

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Enclosure: MPEP §804, Charts I-B and II-B

CONFLICTING CLAIMS BETWEEN: TWO APPLICATIONS *

CHART I-B

DIFFERENT INVENTIONS
(Not Patentably Distinct)

Currently Commonly Owned:
Different Inventive Entities

No Common Assignee or Inventor

At least One Common Inventor, No Common Assignee

Same Inventive Entity

And

Provisional Obviousness Double-Patenting Rejection
8.33 & 8.35 or 8.37

Provisional Rejection of Later Application Under 102(e)/103(a)
7.21.01

Rejection Under 102(f)/103(a) or 102(g)/103(a)
7.21

Let Senior Party Issue or Publish (if published, go to Chart III-B) and Reject Junior Party Under 102(e)/103(a)
7.21

Provisional Obviousness Double-Patenting Rejection
8.33 & 8.35 or 8.37

Commonly Owned at Time of Applicant's Invention

And

Provisional Obviousness Double-Patenting Rejection
8.33 & 8.35 or 8.37

Provisional Rejection of Later Application Under 102(e)/103(a) (for applications filed prior to Nov. 29, 1999)
7.21.01

No showing of Common Ownership at Time of Applicant's Invention

And/Or

Rejection Under 102(f)/103(a) or 102(g)/103(a)
7.21

And

Assignee Required to Either:
(a) Name First Inventor of Conflicting Subject Matter Under 102(f) or (g)
or
(b) Show Inventions Were Commonly Owned at Time of Applicant's Invention
8.28

And

Provisional Obviousness Double-Patenting Rejection
8.33 & 8.35 or 8.37

And

Provisional Rejection of Later Application Under 102(e)/103(a)
7.21.01

CONFLICTING CLAIMS BETWEEN: APPLICATION AND A PATENT

CHART II-B